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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/058,656 | 01/30/2002 | Yoshihisa Tsukada | 0649-0821P-SP | 3874 |

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EXAMINER

CHEA. THORL

ART UNIT PAPER NUMBER

1752

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/058,656

Applicant(s)

TSUKADA ET AL.

Examiner

Thorl Chea

Art Unit

1752

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____


3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-3 and 5-17.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Thorl Chea
Primary Examiner
Art Unit: 1752

Continuation of 5. does NOT place the application in condition for allowance because: of the reason set forth in the final office action, and the limitation such as "(w)herein the polymer is not subjected to purification " is related to the claiming of the material by a process which fails to differentiate the claimed invention and that of the applied prior art of record.. Also, the argument on October 14, 2003 fails to over the rejections set forth in the office action of record. First, the applicants fails to show that the latex taught in the EP'691 does no contain the halogen contents within the scope of the claimed invention. Second, the specification disclosure stated that the results of the present invention is "extremely improved" (see page 175, first paragraph) . The "unexpected results" presented in the argument is based on the counsel's assertion. To overcome the prima facie case of obviousness, the results should have been found unexpected by the worker of ordinary skill in the art at the time the invention was made. Third, the results in Table 1 of the specification show that image preservability of the inventive sample is higher than that of the comparative sample. Note for instance the image preservability of samples 10 vs the samples 104-121 and the coating property of the inventive sample 121 is similar to that of 102 and lower than 101. Accordingly, the results are not found unexpected .